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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,266	10/12/1999	SAMUEL GEORGE MAROPIS	8285/238	7233

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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/20/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/417,266

Applicant(s)

MAROPIS ET AL.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 16-19 is/are allowed.
- 6) ☒ Claim(s) 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2645

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments with respect to claims 14 and 15 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

Art Unit: 2645

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. Patent No. 5,719,926) ("Hill"), newly cited, in view of Asfar et al. (U.S. Patent No. 5,970,129) ("Asfar"), newly cited.

Hill discloses all within the claims except the prepaid, calling card service is provided by a "local" telephone company. However, Asfar is relied upon to teach that local telephone companies also provide prepaid, calling card services.

With respect to claim 14, see the following paragraphs for details on how Hill discloses particular limitations within the claim.

"[E]stablishing a prepaid subscriber account on a prepaid...telephone service database, the prepaid subscriber account comprising comprising subscriber identification information and a period of prepaid service" reads on the abstract, Fig. 1, file server 12, col. 4, lines 5-9, and col. 7, lines 1-60 where established prepaid subscriber account data is

Art Unit: 2645

stored on a telephone service database in the file server 12 database. The account comprises subscriber identification information (e.g., account number) and period of prepaid service (e.g., expiration date).

"[M]onitoring the period of the prepaid service for the prepaid subscriber account at the prepaid...telephone service database independently of a duration and a dollar value of a prepaid subscriber telephone call" reads Hill as follows. The expiration date is described as the date where the "user account will be deemed invalid on this date and cannot be used thereafter" (col. 7, lines 28-32). Therefore, the expiration date (period of prepaid service) is monitored in order to "deem" the user account invalid after the expiration date. Therefore, the expiration date is independent of both call duration and dollar value amount per call.

"[S]ending service termination information to the subscriber prior to an expiration of the period of prepaid service" reads on Fig. 4B, step 79 and col. 5, lines 58-61 where a warning message is played to the caller a set amount of time before termination of the call (service termination information). Because the caller must place the prepaid call in

Art Unit: 2645

the first place before hearing the service termination warning, the prepaid account is not expired when the caller places the prepaid call as discussed above. Therefore, the service termination information (warning message) is sent to the subscriber prior to an expiration of the period of prepaid service (account expiration date).

Although Hill discloses that the subscriber prepaid account is provided by a long distance telephone company, Hill fails to disclose that the account is also provided by a "local" telephone company.

However, Asfar also teaches of a calling card service (abstract) where a prepaid account is provided by a local telephone company and where the long distance telephone company is used to help provide some of the calling card services for the local telephone company (col. 2, lines 45-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a calling card service where the subscriber prepaid account is provided by a local telephone company where a long distance telephone company is used to help provide some of the calling

Art Unit: 2645

card services for the local telephone company as taught by the calling card service of Asfar to the calling card service of Hill.

The suggestion/motivation for doing so would have been increase business revenue and to decrease capitalization and maintenance costs by allowing a local telephone company to sell calling card services to its own customers while relying on a long distance telephone company to provide capital intensive and advanced infrastructure services. In addition, the long distance telephone company as disclosed in Hill would have increased business revenue by "sell[ing] long distance service to local exchange carriers [local telephone companies]" (Asfar, col. 2, lines 45-54).

With respect to claim 15, see Hill, Fig. 4A, step 50 regarding the incoming call step and col. 7, line 47 where the account balance equates to a value identification code. See also steps 60 and 62 where the user sends calling card account data to the service. The entry of account data is an "order" for calling card "service" according to the submitted account data. See the claim 14 rejection above for further details

Art Unit: 2645

regarding the creation of a subscriber account and the determining a service period (expiration date).

***Allowable Subject Matter***

Claims 1-13 and 16-19 are allowed.

***Examiner's Reasons for Allowance***

Independent claims 1, 8, and 16 are directed to a prepaid local telephone service where a telephone call is received from the subscriber, a prepaid account in a local telephone service is identified for the subscriber, a value identification code associated with the prepaid service is received, and a period of the prepaid service is determined. The period of prepaid service is monitored independently of a duration of any prepaid telephone call made during the period of service. With respect to claims 1 and 8, termination date information is sent to the subscriber prior to the expiration of the period of service where the expiration of service is unrelated to a duration of individual subscriber calls made during the service period. With respect to claim 16, a reminder message is sent to the subscriber prior to expiration of service and a suspend message is sent to the telephone network that places the subscriber account on hold and in an inactive state.



Art Unit: 2645

The closest prior art of record is Hill as applied above. Hill fails to disclose a "local" prepaid telephone service however this would have been an obvious addition in view of Asfar as applied above. However, the combination of Hill in view of Asfar still fails to disclose 1) sending termination date information to the subscriber prior to expiration of service where the expiration is unrelated to duration of individual subscriber calls made during the service period, or 2) sending a reminder message prior to expiration and sending a suspend message that places the subscriber account on hold and in an inactive state.

Cohen et al. (U.S. Patent No. 5,946,380) ("Cohen"), as applied in the previous Office action is another close prior art of record. However, Cohen fails to that the prepaid service is monitored independently of a during of any prepaid telephone call made during the period of service.

The remaining prior art of record fails to teach or fairly suggest the obviousness of substantially modifying either Hill in view of Asfar of Cohen in order to arrive at the invention as claimed by the applicant.

Art Unit: 2645

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put into a condition for allowance.

#### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 2645

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.

  
SCOTT L. WEAVER  
PRIMARY EXAMINER  
Art Unit 2645

P.C.F.  
r.g.f.  
November 16, 2002